

Remarks

By the present communication, claims 25 - 28 have been cancelled without prejudice, subject to Applicants' right to pursue the subject matter thereof in one or more subsequent filings which claim priority from the present application. Upon entry of the amendments submitted herewith, claims 24 and 30 will remain pending. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination, is presented in the Listing of Claims, beginning on page 2 of this communication, with an appropriate status identifier for each claim.

Inventorship

Applicants have previously submitted a request to amend the inventorship of the present application to add Halle Morton and Alice Christina Cavanaugh as inventors herein. While the request to correct inventorship was inadvertently identified as being filed under 37 CFR § 1.48(c), is it respectfully submitted that Applicants have met all the requirements to amend inventorship pursuant to 37 CFR § 1.48(a), i.e., statements in support of the Request, a replacement Oath and Declaration signed by all inventors of the claimed subject matter, and a Consent of Assignee.

Thus, it is respectfully requested that the previously submitted Request to Correct Inventorship documentation be treated as a request pursuant to 37 CFR § 1.48(a), for which all requirements have been met.

Rejection under 35 U.S.C. § 112, first paragraph (written description)

The withdrawal of the rejection of claims 1-7, 9-16, 18-20 and 22-28 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement, is acknowledged with appreciation.

Foreign Priority

The acknowledgement that at least claims 24 and 30 are entitled to the claimed priority date of 6 November 2002 (based on priority document Australian Provisional Patent Application No. 2002952492) is acknowledged with appreciation.

Rejections under 35 U.S.C. § 102

... under 102(b) over Coates

The withdrawal of the rejection of claims 20, 22-26 and 28 under 35 U.S.C. §102(b), as allegedly being anticipated by Coates et al. (WO 02/40038) is acknowledged with appreciation.

... under 102(b) over Morton

The withdrawal of the rejection of claims 16, 18-20 and 22-24 under 35 U.S.C. §102(b), as allegedly being anticipated by Morton et al. (US Patent No. 6,117,421) is acknowledged with appreciation.

... under 102(a) over Somodevilla-Torres

The withdrawal of the rejection of claims 16, 18, 20, 22, 24 and 29 under 35 U.S.C. §102(a), as allegedly being anticipated by Somodevilla-Torres et al. (Protein Expression and Purification 32:276-287 (2003)) is acknowledged with appreciation.

Rejections under 35 U.S.C. § 103(a)

... under 103(a) over Morton in view of Kimura

The withdrawal of the rejection of claims 1-7, 9-16, 18-20 and 22-28 under 35 U.S.C. §103(a), as allegedly being unpatentable over Morton et al., in view of Kimura et al. (J of International Medical Research 29:214-221 (2001) is acknowledged with appreciation.

... under 103(a) over Morton + Kimura +Somodevilla-Torres

The withdrawal of the rejection of claims 8 and 29 under 35 U.S.C. §103(a), as allegedly being unpatentable over Morton in view of Kimura, as applied to claims 1-7, 9-16, 18-20 and 22-28 above, and further in view of Somodevilla-Torres et al. is acknowledged with appreciation.

The rejection of claims 25- 28 under 35 U.S.C. §103(a), as allegedly being unpatentable over Morton in view of Kimura, as applied to claims 1-7, 9-16, 18-20 and 22-28 above, and further in view of Somodevilla-Torres et al. is respectfully traversed, and has been rendered moot by the amendments submitted herewith. While Applicants respectfully disagree with this rejection, in order to reduce the issues and expedite prosecution, the subject claims have been cancelled herein.

Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a) are respectfully requested.

Obviousness-type Double Patenting

The provisional rejection of claims 24-28 and 30 as allegedly being unpatentable over claims 1-27 of copending Application No. 12/090821 is respectfully traversed. To the extent such issue may properly be asserted, it can be resolved during prosecution of the later-filed ‘821 application. According to MPEP § 804(I)(B)(1) “If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.” Accordingly, Applicants respectfully request that, if the current claims are considered to be in condition for allowance absent any double patenting issues, the obviousness-type double patenting rejection be withdrawn with resolution thereof deferred until prosecution of Application No. 12/090821 on the merits.

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The provisional rejection of claims 24-28 and 30 as allegedly being unpatentable over claims 10 and 46 of copending Application No. 11/995524 is respectfully traversed. To the extent such issue may properly be asserted, it can be resolved during prosecution of the later-filed '524 application. As noted above, if the current claims are considered to be in condition for allowance absent any double patenting issues, the provisions of MPEP § 804(I)(B)(1) apply, and the obviousness-type double patenting rejection should be withdrawn, with resolution thereof deferred until prosecution of Application No. 11/995524 on the merits.

Conclusion

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and favorable action on all claims. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to contact the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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